

Appl. No. 09/895,027
Atty. Docket No. 8610
Response dated September 22, 2004
Reply to Office Action of June 22, 2004
Customer No. 27752

REMARKS

Claims 1-9 and 14 are pending in the application and stand rejected. Claims 1-9 and 14 have been rejected under 35 U.S.C. § 112, 35 U.S.C. § 102, and 35 U.S.C. § 103.

Rejections Under 35 U.S.C. § 112, second paragraph

The Office Action states that Claims 1-9 and 12 are rejected under 35 U.S.C. § 112, second paragraph as indefinite. Claim 12 is not pending in the application. Therefore, it is assumed that the indication of Claim 12 was a typographical error and Claim 14 was indented instead.

All of the rejections under 35 U.S.C. § 112, second paragraph stem from the recitation of the limitation in Claim 1 "calculated with respect to at least one of said customers." The Office Action takes the position that this renders the claims indefinite because one of ordinary skill in the art would not be able to ascertain how the consumer sales projection information is calculated.

These rejections are respectfully traversed. The Office Action merely states a conclusion of indefiniteness without any analysis or support for this conclusion. The central test under the definiteness requirement is that the claims set out with a reasonable degree of clarity and particularity the claimed subject matter. An indefiniteness rejection requires the examiner to take into account the content of the particular application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art. MPEP 2173.02. In the instant case, there is now showing that one of skill in the art would not understand the claim term at issue when interpreted in light of the specification.

The ability of one of skill in the art to practice the claimed invention is not a definiteness issue but an enablement issue. The Office Action puts forth no showing under the factors announced in In re Wands, 858 F.3d 731, 8 USPQ 2d 1400 (Fed. Cir. 1988) that the claims are not enabled. Without a proper analysis supporting a conclusion of indefiniteness, this rejection cannot be adequately addressed. As the claims would be clearly understood by one of ordinary skill in the art in light of the specification as written, these rejections are respectfully traversed and should be withdrawn.

Appl. No. 09/895,027
Atty. Docket No. 8810
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Rejections under 35 U.S.C. § 102 over Peterson et al. (U.S. 6,324,522)

Claim 1-9 and 14 have been rejected as anticipated by Peterson et al. (U.S. 6,324,522). The Peterson et al. reference does not anticipated Claim 1. Therefore, these rejections should be withdrawn.

The Office Action alleges generally on Page 3 that "the various information provided" in Peterson et al. satisfies the limitations of Claim 1 pertaining to providing product information to consumers. There is no analysis in the Office Action demonstrating that this is the case. Claim 1 specifically requires that the product information provided be customized on the basis of customer information and that the information provided comprise consumer sales projections calculated with respect to the customer. There is no indication in the Office Action how Peterson et al. satisfies either limitation. It appears that Peterson et al. is directed to a network of vendors (which are admitted to be analogous to customers as that term is used in claim 1). However, the vendors of Peterson et al. communicate information about product inventory. There is no indication that the information about the product itself provided to the vendor is customized on the basis of vendor information (or customer information). Additionally, there is no indication in Peterson et al. that the information comprises any consumer sales projection information as is required by Claim 1. As the Office Action has not demonstrated that each and every element of Claim 1 is disclosed in Peterson et al. this rejection is improper and should be withdrawn. Claims 2-9 and 14 depend on Claim 1 and should be withdrawn for at least the same reasons given with respect to Claim 1.

Rejection Under 35 USC 103(a) Over Roberts et al. (U.S. 6,101,486)
in view of Brockman et al. (U.S. 5,826,240)

Claims 1-9 and 14 have been rejected under 35 U.S.C. § 103 as unpatentable over Roberts et al. (U.S. 6,101,486) in view of Brockman et al. (U.S. 5,826,240).

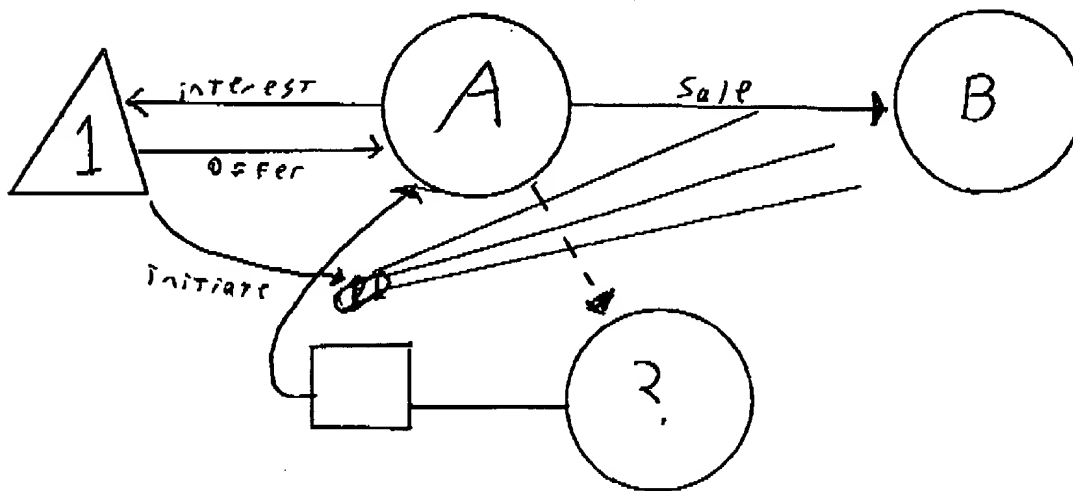
At the outset, some general comments which are relevant to both the rejections under § 102, and the rejections under § 103 discussed below may be helpful in an effort to advance prosecution. There appears to be a question as to whether the applicant intended to be his own lexicographer in the instant application. For the sake of clarity in the record, it is noted that the specification sets for express definitions of the terms "customer," "consumer," and "goods" and that these express definitions are intended to be used when construing the claims. The applicant was expressly intending to be his own lexicographic insofar as the express definitions of claim

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 Customer No. 27752

terms set forth in the specification are to be used for claim construction purposes. Any ambiguity on this point should be clarified by this statement.

It is appreciated that claim terms such as "customer" and "consumer" are similar and in some circumstances a particular person or party could be either a consumer or customer. Nevertheless, it is clear from Claim 1, that both consumers and customers are relevant parties to the claim and in a given particular case are distinct groups. In other words, the claimed flow of information and the frame of reference with respect to calculation and information flow must be maintained once the initial identification of customer or consumer is made.

The diagram below may be helpful in illustrating the features of Claim 1:



The triangular block labeled "1" is a representation of the frame of reference of the provider of the system or the person practicing the claimed method.

The circle labeled "A" is the customer.

The circle labeled "B" is the consumer.

The circle with the "?" is the claimed database.

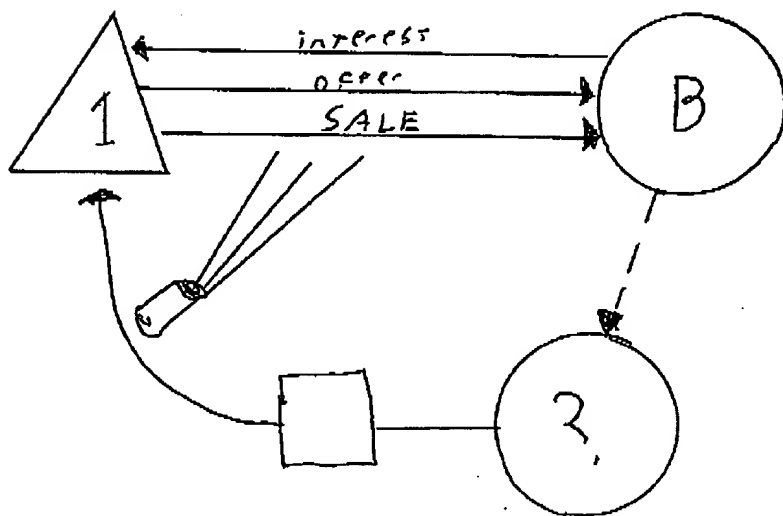
The dotted line represents accessing of database information. The square represents the claimed calculation.

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The spotlight with light beams presents the information provided in step (e). In particular it is important to note **which transaction** this information pertains to.

Even assuming the combination of Roberts and Brockman or Roberts and Peterson is proper in the first instance (which is expressly not conceded), the resulting combination does not teach or suggest all elements of Claim 1.

The diagram below represents a system that would result from the combination of Roberts and Brockman, even assuming the propriety of this combination.



All of the symbols in this diagram have the same meaning as explained above.

As can be seen the **transaction** about which sales information is provided is the sale to the **customer**, not to the **consumer**. Even if one allows that the consumer can be put in the place of the customer, there is a transaction missing and there is an information flow based upon a claimed calculation missing. In other words, even if the consumers of Roberts and Brockman could properly be considered customers, for purposes of the claim, (i.e. "B" could be "A") the diagram above would result and the information pertaining to the sales to **consumers** would still be missing. Claim 1 requires **both** a **consumer** and **customer**. The items being on sales does not render inherent that information provided about that sale will be **pertinent to the claimed**

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Customer No. 27752

relevant transaction (i.e. that between the purchaser/user of the system and a downstream buyer). Additionally, as shown, Roberts and Brockman both deal with sales projection information of the provided of the system (i.e. triangle "1"). By contrast, Claim 1 requires that this information pertain to the the customer (circle "A").

The same rationale applies to the combination of Roberts with Peterson. It is not sufficient to merely conclude that the information provided in step (e) "are not functionally involved" and therefore obvious. It is a legal requirement that the claim be examined as a whole. It is noted that the information of step (c) is not merely "descriptive material." Even it were, however, the Office Action gives no rationale for treating this limitation differently than the others. As shown in the above diagrams the claimed invention differs fundamentally from the prior art in that the invention provided pertains to a **wholly different transaction**. The fact that that prior art shows similar information pertaining to wholly different transactions does not make claim 1 as a whole obvious in light of this art.

All of the remaining arguments in support of patentability of these claims made in the Appeal Brief continue to apply. These arguments are expressly incorporated by reference herein. The additional explanation provided in this reply and the arguments previously made clearly show how Claim 1, and therefore, Claims 2-9 and 14 define over the cited art. Therefore, all of the claims should be allowed.

Conclusion

All of the relevant rejections and objections in the Office Action have been addressed.

No new matter has been added by this response.

In light of the discussions contained herein, Applicants respectfully request reconsideration of the rejections and their withdrawal and that all of the claims be allowed.

Issuance of a notice of allowance at an early date is respectfully requested.

Respectfully submitted,

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